

REMARKS

Claims 1, 2, 5-13 and 16-23 are now present in this application. Claims 1, 7, 12 and 18 are independent.

Claims 3, 4, 14 and 15 have been canceled, claim 23 has been added, and claims 1, 2, 5, 7, 12, 13, 16 and 18-20 have been amended. No new matter is involved.

The Office Action restricts to the following inventions, asserted to be patentably distinct species:

Species I, Figure 1, drawn to a first embodiment of a block diagram of an audio recording level controller;

Species II, Figure 4, drawn to a second embodiment of a block diagram of an audio recording level controller;

Species III, Figure 5, drawn to a third embodiment of a block diagram of an audio recording level controller;

Species IV, Figure 6, drawn to a fourth embodiment of a block diagram of an audio recording level controller; and

Species V, Figure 7, drawn to a fifth embodiment of a block diagram of an audio recording level controller.

The Office Action indicates that there is no generic claim and requires Applicant to elect a single species and list the claims that read on that species.

Applicant hereby elects, with traverse, Species I, Fig. 1, claims 1, 2, 5-13 and 16-23.

Moreover, Applicant respectfully submits that claim 1 is generic.

Applicant respectfully submits that restriction should never be required if the search and examination of an entire application can be made without serious burden, even though the application contains claims to independent and distinct inventions. See MPEP §803. The reasons for this are (a) that there are two criteria for proper restriction between patentably distinct inventions. The first is that the inventions must be independent or distinct as claimed, and the second is that there must be a serious administrative burden on the examiner to examine the claimed inventions; and the second is that 35 USC 121 makes restriction discretionary by stating that the Director may require an application to be restricted to one of two or more independent and distinct claimed inventions in an application.

With respect to the issue of “serious administrative burden,” MPEP §§803, 808, 808.01 and 808.02 discuss and explain USPTO accepted meanings of serious administrative burden. In this regard, the Office Action never even addresses the issue of serious administrative burden, and is fundamentally improper for this reason alone. Furthermore, Applicant respectfully submits that historically, the USPTO has considered five species to be a reasonable number of species, as evidenced by the previous version of 37 CFR §1.141, which permitted an Examiner to limit what was searched and examined to five species. This Rule of Practice was amended to be consistent with Rule 13 of the Patent Cooperation Treaty (PCT), after the PCT was passed by Congress. It is Applicant’s understanding that the amendment to 37 CFR §1.141 removed the “five species” language to permit Examiners to consider and examination of claims directed to more than five species, to be consistent with PCT Rule 13. Reference is made, in this regard, to the

Commissioner's Decision in In re Caterpillar Tractor Co., 228 USPQ 77 (Com'r Pats. 1985).

In other words, it is Applicant's position that it is unreasonable for the Examiner to limit examination to claims directed to just a single species based on the long established USPTO policy and practice of examining claims directed to at least five species, that has been in effect for over a half a century, and where there are five species according to the restriction (election of species) requirement. Moreover, at this stage of the prosecution, Applicant respectfully submits that claim 1 appears to be an allowable generic claim that is generic to all pending claims.

Accordingly, the restriction (election of species) requirement is improper. Reconsideration, withdrawal of this requirement are respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment and election of species is respectfully requested.

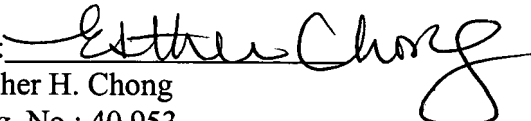
Application No.: 10/758,073
Art Unit 2615

Attorney Docket No. 2950-0252P
Reply to Office Action dated April 27, 2007
Page 11

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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